## REMARKS/ARGUMENTS

### Introduction

In the Office Action mailed on June 10, 2002 (Paper No. 6), the Examiner rejected claims 1-26, 36-38, and 41-43 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,026,3762 to Kenney ("Kenney"); rejected claims 27-35 and 45-47 under 35 U.S.C. § 103(a) over Kenney and U.S. Patent No. 6,272,532 to Feinleib ("Feinleib"); rejected claims 39 and 40 under 35 U.S.C. § 103(a) over Kenney and U.S. Patent No. 6,405,178 to Manchala et al. ("Manchala"); and rejected claim 44 under 35 U.S.C. § 103(a) over Kenney and U.S. Patent No. 5,960,411 to Hartman et al. ("Hartman"). Applicants herein amend claims 1-3, 15, and 17. Claims 1-47 remain pending. For the reasons set forth in detail below, applicants submit that the pending claims are now all in condition for allowance.

### Telephone Interview

Applicants wish to thank the Examiner for the courtesy extended by the Examiner in the telephone interview conducted on July 30, 2003, during which the Examiner confirmed the identity of the Hartman reference relied upon in the prior art rejection of claim 44, and during which the Examiner and applicants' representative discussed alternative claim language for claim 1. Applicants gratefully acknowledge the Examiner's indication that substitution of the word "action" for the word "interaction" in claim 1 would tend to distinguish claim 1 from Kenney.

### Applicants' Techniques

Applicants' techniques are directed to automatically initiating the replenishment of items such as physical products. These techniques establish a target date on which the item presently being used by a customer should probably be replenished. In some cases, these techniques determine the target date based upon the identity of the item. In some cases, the techniques autonomously send a replenishment recommendation to the customer through such communication channels as electronic mail, instant messaging, or voicemail. In some cases, the techniques provide a replenishment recommendation containing a control that the customer may, with a single action, use

to request replenishment of the item. In some cases, the techniques, when they determine that the item should be replenished, automatically cause the item to be replenished, without requiring any action of the user.

## Cited References

### Kenney

Kenney is directed to a much more limited approach to enabling the reordering of items *while the shopper is shopping at a shopping website*. In Kenney, the shopper first creates a list of items that may later be reordered, called a reorder list. (11:21-24) When the shopper is later shopping, the shopper can display the items in the reorder list, and select items from the reorder list to be added to a current list. (11:13-15) The shopper may also enter new items into the current list. (11:15) When the shopper finishes shopping, the user controls his or her local computer to automatically organize the items in the current list, and print it if desired. (11:15-20)

### Feinleib

Feinleib is directed to an email-based reminder system. In Feinleib, a message submitter sends an e-mail message containing information specifying a reminder to deliver in the future. (2:50-53) This information includes a time to send the reminder, the e-mail address of a reminder recipient, and text to include in the reminder. (3:17-30) When the time specified in the reminder arrives, the central computer sends an e-mail message containing the specified reminder to the specified message receiver. (4:28-34)

### Manchala

The application for Manchala was filed on December 20, 1999. Manchala does not claim priority in any earlier-filed application.

### Hartman

Hartman is assigned to Amazon.com, Inc., of Seattle, Washington, as is the present application.

Prior Art Rejections

The Examiner rejected claims 1-26, 36-38, and 41-43 under 35 U.S.C. § 103(a) over Kenney. Applicants respectfully traverse this rejection. Claim 1 formerly recited "providing to the consumer an indication that the product should be replenished, *the indication including a control usable by the consumer to request replenishment of the product by performing a single interaction*." In the Office Action, the Examiner indicated that, while he regards the language "performing a single interaction" to fairly describe the fairly long series of steps a user must take in Kenney in order to order items on a reorder list (select reorder items from a reorder list, enter new items to be selected, and control his or her computer to automatically organize his or her current list), the Examiner does not regard this series of steps to be fairly described by the alternative language "performing a single action." Applicants herein amend claim 1 in order to adopt this alternative language. As a result, claim 1 is patentable over Kenney, as is its dependent claim 44.

Claims 2 and 15 each recite "on the target date, providing to the consumer an indication that the first item should be replenished, *the indication including a user interface control usable by the consumer to request replenishment of the first item*." The Examiner has failed to identify how Kenney either discloses or suggests providing a replenishment indication including such a user interface control as part of a replenishment indication. Likewise, applicants can find in Kenney no such disclosure or suggestion. For this reason, claims 2 and 15 are patentable over Kenney, as are their dependent claims 3-14 and 16-26.

Claims 36 and 38 recite an item replenishment data structure comprised of a plurality of entries. Each entry is recited to comprise "an identification of a consumer, an identification of an item, and *an indication of a target date on which the replenishment of the item is to be proposed*."

The Examiner indicated that it is inherent that Kenney uses a data structure comprising a plurality of entries each corresponding to a different consumer order, each entry containing, for the consumer order, an identification of a consumer, and

identification of at least one item, and an indication of a target date for the item. The doctrine of inherent disclosure requires a showing that, though a claim element is not disclosed explicitly, it is *necessarily* included in a system as described by the explicit disclosure. *In re Robertson*, 169 F.2d 743, 745 (Fed. Cir. 1999). That is, the system *could not work* as described by the explicit disclosure were the claim element not included in the system. This is not the case here. Once a consumer order is placed in Kenney for an item selected by the user from a reorder list, there would be no utility in storing a target date on which the replenishment of the item is to be proposed in a data structure representing the order, as this information is not needed in order to fulfill the order. Accordingly, the system described in Kenney could function properly without storing replenishment target dates in entries, each corresponding to a consumer order, as recited. Moreover, Kenney at no point discusses determining a target date on which the replenishment of the item is to be proposed. Rather, the extent to which Kenney facilitates proposing a replenishment of an item is permitting the user to select the item to store in a reorder list, in which at all subsequent times the item appears. Accordingly, applicants submit that Kenney fails to inherently disclose the recited features discussed above. For this reason, claims 36 and 38 are patentable over Kenney, as is dependent claim 37.

Claim 41 recites "when testing (a condition for suggesting replenishment of the item) indicates that the condition is satisfied, raising an event." The Examiner indicated that raising an event when the condition is satisfied is inherent in Kenney. Applicants respectfully disagree. As a first matter, Kenney does not disclose or suggest suggesting replenishment of an item only when testing a condition for suggesting replenishment of the item is satisfied. To the contrary, Kenney merely describes permitting the user to select a set of items to store in a reorder list. At any point, the user can, on his or her own initiative, display the items on the reorder list, together with indications of their reorder dates. For each item, the reorder date can be a future date, the current date, or a past date. Accordingly, Kenney does not test the condition for suggesting replenishment of an item, nor does it suggest replenishment of the item only where testing indicates that the condition is satisfied, as recited. To the contrary,

Kenney displays the reorder list of items and their target dates each time the user requests display of this list, without testing any condition for suggesting replenishment of a particular item. Further, applicants submit that any activity performed by Kenney that is asserted to constitute testing and condition for suggesting replenishment of the item could quite straightforwardly be implemented using procedural logic and processing, without requiring the use of events as recited. Accordingly, claim 41 is patentable over Kenney, as are its dependent claims 42 and 43.

The Examiner rejected claims 27-35 and 45-47 under 35 U.S.C. § 103(a) over Kenney and Feinleib. According to the Manual of Patent Examining Procedure and controlling case law, the motivation to combine or extend prior art references under 35 U.S.C. § 103(a) cannot be based on mere common knowledge and common sense as to benefits that would result from such combination or modification. Instead, such motivation must be based upon specific teaching in the prior art, such as a specific suggestion in a prior art reference.

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

> *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art*, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Manual of Patent Examining Procedure, § 2143 (emphasis added).

In contrast to this well-established standard, the motivation to combine these two prior art references in accordance with the claimed invention provided by the Examiner is based solely on the alleged beneficial results that would be produced by this combination, without identifying any motivation from the prior art that supports the

extension as is required. Applicants accordingly request that the Examiner reconsider and withdraw this rejection. If the Examiner elects to maintain this rejection, however, applicants respectfully request that the Examiner explain with the required specificity where a suggestion or motivation to combine the references in the manner proposed by the Examiner can be found in the prior art.

The Examiner rejected claims 39 and 40 under 35 U.S.C. § 103(a) over Kenney and Manchala. Manchala does not qualify as prior art against the present application under 35 U.S.C. § 102(e), as its filing date, December 20, 1999, is later than the effective filing date of the present application, December 8, 1999, the actual filing date of U.S. Patent Application No. 60/169,721, whose benefit is claimed by the present application. Manchala also fails to constitute prior art to the present application under 35 U.S.C. § 102(b) as its issue date of June 11, 2002 is not more than one year earlier than the effective filing date of the present application. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Examiner rejected claim 44 under 35 U.S.C. § 103(a) over Kenney and Hartman. Hartman is assigned to Amazon.com, Inc., as is the present application. 35 U.S.C. § 103(c) explicitly precludes rejections under 35 U.S.C. § 103(a) for references that (1) are only prior art under 35 U.S.C. § 102(e), (f) or (g); and (2) were, at the time the invention was made, owned by the same person or subject to an obligation assignment to the same person as the claimed invention. In this case, the claimed invention was subject to an obligation of assignment to Amazon.com, Inc. at the time it was made. Accordingly, Hartman is not available for a rejection under 35 U.S.C. § 103(a) via 35 U.S.C. § 102(e). Hartman also fails to constitute prior art under 35 U.S.C. § 102(b), as its issue date of September 28, 1999 is not more than one year earlier than the effective filing date of the present application. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.
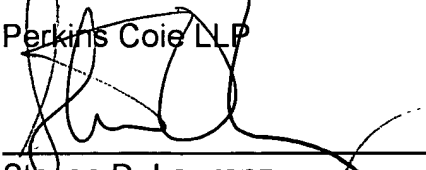
Conclusion

In view of the foregoing, applicants submit that all of the claims pending in the application are allowable. Accordingly, a prompt Notice of Allowance is respectfully

requested. If the Examiner has any questions or believes a telephone conference would expedite examination of this application, he is encouraged to call the undersigned at (206) 359-6373.

Respectfully submitted,

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